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Sunao Takatori

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EXAMINER

TINKLER, MURIEL S

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/089,122

**Applicant(s)**

TAKATORI ET AL.

**Examiner**

MURIEL TINKLER

**Art Unit**

3691

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2010.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4,5,7-10,12-15,25,27,29,32 and 33 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 4,5,7-10,12-15,25,27,29,32 and 33 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This application has been reviewed. The status of the claims are as follows: claims 1 and 3-31 were previously pending; claims 6, 16-24, 26, 28, 20 and 31 have been cancelled; claims 4, 25 and 27 have been amended; claims 32 and 33 have been added; therefore claims 4, 5, 7-10, 12-15, 25, 27, 29, 32 and 33 are currently pending and have been examined. The rejections are as follows.

### ***Response to Arguments***

1. Applicant's arguments, see page 9, filed June 21, 2010, with respect to the 35 USC 112 Rejection(s) have been fully considered and are persuasive. The 35 USC 112 Rejection(s) of claims 1 and 3-31 has been withdrawn. It appears to be clear, and the Examiner has interpreted that the "transfer source store account information" is the (bank or billing) account information for the store.
2. Applicant's arguments, see pages 10-14, filed June 21, 2010, with respect to the rejection(s) of claim(s) 1 and 3-31 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Morrill (US Patent 5,991,749).
3. Please note: The Examiner has previously conducted an interview with the Applicant's representatives Jason Eisenberg and Dina Blikshiteyn to discuss the invention and prior art. The Examiner was supposed to meet again with the Applicant's representative. However, the Examiner was unable to set up this meeting with the

Applicant's representative in appropriate time. Therefore, the Examiner is sending out this rejection as a non-final Office Action.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 4, 5, 7, 12, 25, 27, 29, 32 and 33 rejected under 35 U.S.C. 102(b) as being anticipated by Morrill (S Patent 5,991,749), hereafter referred to as Morrill.

6. Regarding claims 4, 25, 27 and 32, Morrill discloses:

a. A store communication terminal (i.e. a mobile phone provider's cellular antenna, see column 2, lines 29-31), comprising:

b. a memory (i.e. CPU) configured to store transfer source store account information and store ID information, see column 2 (lines 29-31);

c. a receiver configured to receive customer ID information from a memory of a customer mobile communication device (i.e. cell antenna, see column 2 (lines 29-31));

d. an input device (i.e. mobile phone) configured to input monetary amount information that a store is to pay a customer (see column 2 (lines 29-31); and

- e. a transmitter (i.e. user) configured to transmit at least one of the store ID information (i.e. vendor code, column 2 (line 63) through column 3 (line 3)), the transfer source store account information (i.e. destination account information, column 3 (lines 6-7), the customer ID information (column 3 (lines 3-4)) and the monetary amount information (column 2, lines 47-48) to the customer mobile communication device for authentication (column 2, lines 63-67), ← also note, Morrill also discloses a case where the input device (i.e. computer) transmits (i.e. displays) to the user the store account information, see column 11 (lines 26-33).
- f. wherein the receiver (first authenticator, i.e. mobile phone) is configured to receive the authenticated store ID information (column 2, lines 63-67), transfer source store account information (column 2, lines 6-7), customer ID information (column 3, lines 3-4) and monetary amount information (column 2, lines 47-48) from the customer mobile communication device and
- g. if the authentication using the customer mobile communication device is successful the transmitter is configured to transmit the store ID information, transfer source store account information, customer ID information and monetary amount information to an authentication manager (second authenticator, mobile communication provider cellular antenna, column 2 (lines 29-31)) that further authenticates the at least one of the authenticated store ID information, transfer source store account information, customer ID information and monetary amount information (column 3, lines 6-11), and

- h. wherein the authentication manager communicates with a first financial institution based on the store ID information and retrieves information of a store account and communicates with a second financial institution based on the customer ID information and retrieves information on a customer ID account (i.e. mobile phone bills—column 3, lines 11-15; mobile phone bills and other financial institutions--column 3, lines 24-35), and
  - i. wherein, upon successful authentication using the authentication manager, a monetary amount based on the monetary amount information is transferred from the store account of the first financial institution to the customer account of the second financial institution (column 3, lines 11-35).
- 7. Regarding claim 5, Morrill discloses: The store communication terminal in accordance with claim 4, wherein the input device is further configured to input the transfer source store account information (inputting the destination account code, column 3 (lines 6-7).
- 8. Regarding claims 7 and 12, Morrill discloses: The store communication terminal in accordance with Claim 4, wherein the store communication terminal is a mobile communication terminal (mobile phone providers cellular antenna—column 2, lines 29-31).
- 9. Regarding claim 29, Morrill discloses: The store communication terminal in accordance with Claim 4, wherein the store communication terminal, the customer

mobile communication device, and the authentication management apparatus communicate with each other through an Internet network (column 10, lines 60-64) ← while this is a separate embodiment of the invention (use via a computer), the Examiner notes that in Morrill's invention the mobile communication's device (i.e. mobile phone) is communicating with the authentication management apparatus (in the case of this embodiment, it is the computer) via the Internet.

10. Regarding claim 33, Morrill discloses: The system in accordance with Claim 32, wherein the authentication manager is configured to stop the transfer device from transferring the money in response to receiving cancel information from the store communication terminal (column 3, lines 6-8) ← the Examiner points out that there are several 'checks' or chances to cancel throughout Morrill's process..

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrill as applied to claims 4 and 5 above, and in further view of Woolston (US 6,085,176 A).

13. Regarding claims 8 and 13, Morrill discloses: The store communication terminal in accordance with Claim 4, wherein the store communication terminal comprises a pawnshop communication terminal. Morrill discloses the information in claims 4 and 5, see the discussion(s) above. The Examiner points out that it does not matter where this communications terminal is used, or what it is used for as long as it performs the functions listed (i.e. HOW it is being used/functionality/steps performed). And, as Morrill does disclose the required functionality, then the fact that the store communications device comprises a pawnshop communication terminal can be considered as being taught by Morrill. However, for purposes of compact prosecution, the Examiner will assume that a 'pawnshop communication terminal' communications terminal has 'additional' capabilities not found in other communications terminals. Morrill does not specifically disclose the use of a terminal at a pawnshop. Woolston teaches the use of a terminal at a pawnshop in column 5 (lines 53-67) and column 6 (lines 1-14). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a pawnshop because it is easily accessibly to the public and a pawnshop is a type of store that was well known at the time this invention was made.

14. Claims 9, 14, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrill as applied to claims 4 and 5 above, and in further view of Gustin et al. (US 6,012,048 A).

15. Regarding claims 9 and 14, Morrill discloses: The information in claims 4 and 5, see the rejection(s) above. Morrill does not disclose: wherein the store communication terminal comprises a lottery money-exchanging device. The Examiner points out that it does not matter where this communications terminal is used, or what it is used for as long as it performs the functions listed (i.e. HOW it is being used/functionality/steps performed). And, as Morrill does disclose the required functionality, then the term 'lottery money-exchanging device' can be considered as being taught by Morrill. However, for purposes of compact prosecution, the Examiner will assume that a 'lottery money-exchanging device' communications terminal has 'additional' capabilities not found in other communications terminals. Gustin et al. teaches the use of a lottery money-exchanging booth in the Background of the Invention, Summary of the Invention, column 9 (lines 46-59), column 21 (lines 4-34), column 22 (lines 4-26 and 32-44). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a lottery machine because lottery machines have a large volume of usage and because the purchase of end-user items is less susceptible to fraud, they do not require the additional security for transactions as cashing checks or money orders as discussed in Gustin, Background of the Invention. Additionally, lottery machines were old and well known in the art at the time this invention was made.

16. Claims 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrill as applied to claims 4 and 5 above, and in further view of Fernandez (US 6,266,647 B1).

17. Regarding claims 10 and 15, Morrill discloses: The information in claims 4 and 5, see the rejection(s) above. Morrill does not disclose: wherein the store communication terminal comprises a prize-exchanging booth of a pachinko device. The Examiner points out that it does not matter where this communications terminal is used, or what it is used for as long as it performs the functions listed (i.e. HOW it is being used/functionality/steps performed). And, as Morrill does disclose the required functionality, then the term 'prize exchanging booth of a pachinko device' can be considered as being taught by Morrill. However, for purposes of compact prosecution, the Examiner will assume that a 'prize exchanging booth of a pachinko device' communications terminal has 'additional' capabilities not found in other communications terminals. Fernandez teaches the use of a Pachinko parlor in the Summary of the Invention, column 4 (lines 24-34 and 60-65), column 8 (lines 57-67), column 9 (lines 1-5) and claim 17. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a location that has pachinko games because it is easily accessible to the public. Additionally, pachinko parlors were old and well known in the art at the time this invention was made.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURIEL TINKLER whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 8:30 AM until 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Muriel Tinkler/  
Examiner, Art Unit 3691